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**Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/675,280    07/01/96    WEBER

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QM02/0810

EXAMINER
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ATKINSON, C

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 08/10/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/675,280

Applicant(s)

Hieber et al.

Examiner

D. H. Johnson

Group Art Unit

3743

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 5/2/2000 and 9/30/99
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-2, 7-8, 17-22 and 25-31 is/are pending in the application.
- Of the above claim(s) 1-2, 7-8, 17-22 and 29 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 25-28 and 30-31 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☒ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

Art Unit: 3743

***Response to Election and Amendment***

Applicant's election with traverse of the Group II invention in Paper No. 32 is acknowledged. The traversal is on the ground(s) that the grouping of the claims is not consistent with the wording of the claims. This is not found persuasive because this is not a requirement in giving a restriction requirement. Since applicant has not provided any arguments that the product cannot be used in a materially different process, the requirement is still deemed proper and is therefore made FINAL.

Claims 1-2, 7-8, 17-22 and 29 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention. Claim 29 does not read on elected species B as illustrated in Figure 2. Claim 29 reads on non-elected species A as illustrated in Figure 1 which has been abandoned by applicant. Applicant timely traversed the restriction (election) requirement in Paper No. 32.

***Specification***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of 37 CFR 1.71(a)-(c):

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to

Art Unit: 3743

which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

(c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

The specification is objected to under 37 CFR 1.71 because the originally filed specification fails to disclose the device of claims 26, 28 and 31.

The amendment filed 3/17/1997 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "or aluminum fibers".

Applicant is required to cancel the new matter in the reply to this Office action.

***Claim Rejections - 35 USC § 112***

Claims 26, 28 and 31 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had

Art Unit: 3743

possession of the claimed invention. The originally filed specification fails to disclose the device of claims 26, 28 and 31.

Claims 25-28 and 30-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The recitation "said voids" in claims 25 and 30 lacks antecedence. Also in claim ~~25~~<sup>30</sup>, the recitation "enclosure from externally of said enclosure" appears to be grammatically incorrect. In claim 28, the recitation "said chamber" lacks antecedence. In view of the plurality of claim problems, applicant is requested to review all claims and correct all problems.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --  
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 25-27 and 30-31 are rejected under 35 U.S.C. § 102(b) as being anticipated by Telkes.

The patent of Telkes, in Figure 4, discloses applicant's claimed invention.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3743

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

Claim 28 is rejected under 35 U.S.C. § 103 as being unpatentable over Telkes in view of Knoell et al. The patent of Telkes discloses all the claimed features of the invention with the exception of a portion of the enclosure includes a composite of highly thermally conductive fibers disposed in a matrix.

The patent of Knoell et al., in Figures 1 and 2, discloses that it is known to have a portion of an enclosure including a composite of highly thermally conductive fibers disposed in a matrix for the purpose of increasing the strength and controlling the thermal expansion and conductivity of the enclosure. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to employ in Telkes a portion of the enclosure including a

Art Unit: 3743

composite of highly thermally conductive fibers disposed in a matrix for the purpose of increasing the strength and controlling the thermal expansion and conductivity of the enclosure as disclosed in Knoell et al.

***Response to Arguments***

Regarding applicant's amendment, Telkes, in Figure 4, is believed to disclose applicant's claimed invention.

The originally filed specification fails to disclose the device of claims 26, 28 and 31.

Regarding claim 28, the originally filed specification does not disclose the matrix fibers extending into a chamber but rather "the fibers (13) ... without matrix" extending into a cavity.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

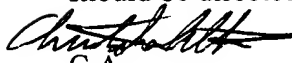
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this

Art Unit: 3743

final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Atkinson whose telephone number is (703) 308-2603.

 CHRISTOPHER ATKINSON  
C.A. PRIMARY EXAMINER

August 8, 2000